

REMARKS

Reconsideration of the pending application is respectfully requested in view of the following observations.

1. In the Drawings

As requested in the Action, the applicant amends Fig. 1 to include appropriate labeling for the drawing elements in the appended REPLACEMENT SHEET. Entry of the amendment to the drawings is kindly requested in the next Office communication.

2. In the Specification

Appropriate section headings are added to the specification in the AMENDMENT TO THE SPECIFICATION. In addition, the specification is amended by the removal of reference to the claims.

No new matter is entered by way of this amendment to the specification.

Acceptance of the amendment to the specification is requested in the next communication from the Examiner.

3. In the Claims

Independent claim 1 is amended to recite that the method for recognizing forged bank notes is performed by a bank note processing machine. In addition, claim 1 is amended to indicate that the additional comparative data for new types of forgeries are those "which are not recognized based on the comparative data derived from authentic bank notes and known forgeries."

Independent claim 6 is amended to include the same amendatory language with regard to the additional comparative data as found in amended claim 1.

Support for the amendatory language is found at least in paragraph [0007]. Therefore, no new matter is entered by way of this amendment to the claims.

Entry of the amendment to the claims is kindly requested in the next Office communication.

4. Rejection of claims 1-5 under 35 U.S.C. § 101

In view of the amendment to independent claim 1, from which claims 2-5 depend, reconsideration of this rejection is respectfully requested. Specifically, the method for recognizing forged bank notes is characterized as being performed by a bank note processing machine which stores comparative data. Thus, the amendment to claim 1 is tied to a particular apparatus by means of the bank note processing machine.

Accordingly, amended claim 1 falls within statutory subject matter.

Withdrawal of the rejection of claims 1-5 is therefore requested.

5. Rejection of claims 1-3 and 5-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2003/0132281 (*Jones et al.*) in view of the publication "Signature Verification: Increasing Performance by a Multi-Stage System" (*Sansone et al.*)

Reconsideration of this rejection is respectfully requested in view of the amendment to independent claims 1 and 6, and the following observations.

In observing claims 1 and 6, it first must be understood that these claims both require two different types of comparative data to determine whether or not certain bank notes are forgeries. Specifically, both claims are amended to specify that the additional comparative data relates to new types of forgeries which are not recognized based on the comparative data derived from authentic bank notes and known forgeries.

Turning to *Jones et al.*, which is relied upon in the Action as teaching the comparative data and additional data of claims 1 and 6, it is submitted that *Jones et al.* does not teach the use of comparative data and additional comparative data of the type required by claims 1 and 6.

Jones et al. only teaches providing a set of comparative data which determines forgeries. There is no additional comparative data used in combination with comparative data stored in the document processing machine.

In reference to Fig. 15 depicting a general description of the operation of the document processing system of *Jones et al.*, it is described in paragraph [0129] that

certain counterfeit tests or comparative data include measuring light emitted from the bill, testing for watermarks, holograms, magnetics, and security threads, and testing image quality. Also, stored serial numbers may be used as such comparative data in the document processing system of *Jones et al*

The newly determined serial numbers in reference to the embodiments H and I of *Jones et al* do not amount to the additional comparative data of amended claims 1 and 6. *Jones et al* describes in embodiments H and I that only after bank notes are determined to be counterfeit based on the already stored counterfeit tests, the serial numbers are extracted from the bank notes and added to the memory of the document processing system ([0183]-[0185]).

Thus according to *Jones et al*, the bank notes must first be identified as being counterfeit before any serial numbers are extracted and stored by the document processing system. It follows that if a counterfeit bank note is processed by the document processing system of *Jones et al*, but the counterfeit bank note of a new type of forgery does not satisfy any of the stored counterfeit tests and is therefore not identified as being counterfeit and judged as being authentic instead, the serial numbers of the counterfeit bank note will not and cannot be extracted and used in future processing of other bank notes. In other words, the extraction and storage of serial numbers according to *Jones et al* of counterfeit bank notes is dependent on at least one bank note first being determined counterfeit by satisfying one of the stored, and thus old, counterfeit tests.

The system according to *Jones et al* is therefore akin to the types of systems discussed in the Background of the pending application wherein new forgeries are not recognized and are thus erroneously judged as an authentic bank note (specification at [0002]-[0004]).

Contrary to the embodiments described by *Jones et al*, the method of amended claim 1 and the bank note processing machine of amended claim 6 require using comparative data and additional comparative data of new forgeries not included in the comparative in order to account for new types of forgeries that may have arisen after the comparative data was established.

As for *Santone et al.*, this reference was correctly not relied upon in the rejection to teach the comparative data and the additional comparative data required by claims 1 and 6. Instead, *Santone et al.* only describes a multi-stage process which recognizes signatures only. There is no teaching in *Santone et al.* that would motivate the skilled person in view of the teachings of *Jones et al.* to provide the comparative data and the additional comparative data required in the amended pending claims.

In view of these of these observations, it is submitted that the proposed combination of *Jones et al.* and *Santone et al.* fails to disclose all of the elements required by claims 1 and 6. The skilled person would not find it obvious to devise the method according to claim 1 and the bank note processing machine according to claim 6 from the proposed combination of teachings in *Jones et al.* and *Santone et al.*

The claims dependent from Claims 1 and 6 are patentable at least based on their dependency from one of claims 1 and 6, and their individually recited features.

Accordingly, withdrawal of the rejection of these claims is courteously petitioned.

6. Rejection of claim 4 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent application publication 2003/0132281 (*Jones et al.*) in view of EP 1255232 (*Pernot*)

Reconsideration of this rejection is kindly requested in view of the discussion above in reference to claim 1 and the shortcomings of *Jones et al.* *Pernot* is relied upon in the Action as processing bank notes independent of their orientation. There is no discussion in *Pernot* with regard to checking bank notes on comparative data and additional comparative data.

Claim 4 depends from claim 1, and is therefore patentable over the proposed combination of *Jones et al.* and *Pernot* at least due to its dependency from claim 1 and its individually recited features. Therefore, the skilled person would not consider claim 4 to be obvious over the combination of *Jones et al.* and *Pernot*.

Accordingly, withdrawal of the rejection of this claim is kindly petitioned.

7. Conclusion

As a result of the amendment to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicant's attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

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